

#40

P&amp;G Case 5494CRL

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of: :  
Roe et al. : Confirmation No.: 9941  
Serial No.: 08/908,852 : Group Art Unit: 3761  
Filed: August 8, 1997 : Examiner: Dennis W. Ruhl

For: Article Having A Lotioned Topsheet

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

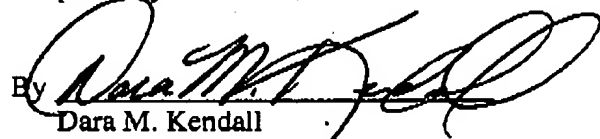
Dear Sir:

Enclosed, pursuant to 37 C.F.R. 1.192(a), is Appellants' brief on Appeal for the above application. The Brief is being forwarded in triplicate.

The fee for this Brief on Appeal is \$330.00 pursuant to 37 CFR 1.17(c).

The Director is hereby authorized to charge the above fee, or any additional fees that may be required, or credit any overpayment to Deposit Account No. 16-2480 in the name of The Procter & Gamble Company. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

By   
Dara M. Kendall  
Attorney for Applicants  
Registration No. 43,709  
(513) 626-1789

Date: November 18, 2003

Customer No. 27752

(BriefonAppealTrans.doc)  
(Last Revised 10/10/2003)

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For DIAPER HAVING A LOTIONED  
TOPSHEET

APPEAL BRIEF

Box AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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This Appeal Brief is submitted in support of the Notice of Appeal submitted to the USPTO on September 18, 2003 via facsimile and received by the USPTO on the same day, which set a two(2)-month period for submission of this Brief. This Appeal Brief is being filed in triplicate.

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This Application has been assigned to The Procter & Gamble Company of Cincinnati, Ohio. The inventors, Donald Carroll Roe, Laura Graves Spalding Van Rijswijk, and Julie Charlene Rule, assigned their interest to the Procter & Gamble Company in an assignment corresponding to application Serial No.09/908,852, filed August 8, 1997 (recorded on November 14, 1997, at reel number 8833, and frame number 885).

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellant, or known to Appellant's legal representative, that will directly affect the Board's decision in the present appeal.

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The present application was originally filed with claims 1-27. On April 3, 2000, Appellants mailed in a response that amended the application by canceling claim 27. In a Response/Amendment mailed on March 26, 2001, Appellants canceled claims 2, 3, 8, 14, and 15. Therefore, in the Office Action mailed on June 18, 2003, the Office finally rejected claims 1, 4-7, 9-13, and 16-26. Accordingly, Appellants hereby appeal the rejection of

each of these claims that have been finally rejected. A complete copy of the appealed claims is set forth in the Appendix.

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#### ISSUES

Appellants present the following issues for consideration on appeal:

- I. Claims 1, 4-7, 9-13, and 16-22 have been rejected under 35 USC §103(a) as being unpatentable over Duncan et al. (USP 3489148) and
- II. Claims 1, 4-7, 9-13, and 16-26 have been rejected under 35 USC §103(a) as being unpatentable over Duncan in view of Buchalter (USP 3896807).

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Claims 1, 4-7, 9-13, and 16-26 stand or fall together.

#### ARGUMENTS

Claims 1, 4-7, 9-13, and 16-22 have been rejected under 35 USC §103 as being unpatentable over Duncan. The Office reasons that Duncan discloses the following: 1) a topsheet 12, 2) absorbent 11, 3) backsheet 11a, 4) that the topsheet has multiple discrete droplets of a lotion composition 14a, 5) that the discrete droplets of lotion have macroscopic areas between them that have no lotion, 6) the droplets have sizes

ranging from 0.05 – 1.0 mm, and that 7) use of a hydrophilic topsheet was known. The Office goes on to state that even though Duncan is mainly concerned with a hydrophobic topsheet, the reference teaches that it was previously known to use lotion on a hydrophilic topsheet. Additionally, the Office goes on to assert that although Duncan does not disclose the open percent area of the topsheet disclosed therein, it is evident that the reference has some value for the percent open area and is just silent as to what it is. Furthermore, the Office points to Duncan's recognition of varying the diameter of the lotion droplets. As a result of these assertions, the Office concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Duncan with the claimed percent open area.

Additionally, Claims 1, 4-7, 9-13, and 16-26 have been rejected under 35 USC §103 as being unpatentable over Duncan in view of Buchalter. The Office states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the skin care composition of Buchalter on the diaper of Duncan so that the benefits of the skin care composition of Buchalter can be obtained on the article of Duncan.

For the reasons discussed below, Appellants submit that the appealed claims are not rendered obvious in view of Duncan alone or in combination with Buchalter. Accordingly, the Board should reverse the Office's rejections. A favorable action by the Board is respectfully requested.

**I. Claims 1, 4-7, 9-13, and 16-22 are not rendered obvious under 35 USC §103(a) by Duncan because the reference fails to teach or suggest the claimed limitations of the present invention.**

Claims 1, 4-7, 9-13, and 16-22 have been rejected under 35 USC §103 as being unpatentable over Duncan. The Office reasons that Duncan discloses the following with respect to claims 1, 4-7, 9-11, 13, and 16-20: 1) a topsheet 12, 2) absorbent 11, 3) backsheet 11a, 4) that the topsheet has multiple discrete droplets of a lotion composition 14a, 5) that the discrete droplets of lotion have macroscopic areas between them that have no lotion, 6) the droplets have sizes ranging from 0.05 – 1.0 mm, and that 7) use of a hydrophilic topsheet was known. The Office goes on to state that even though Duncan is mainly concerned with a hydrophobic topsheet, the reference teaches that it was previously known to use lotion on a hydrophilic topsheet. Additionally, the Office goes on to assert that although Duncan does not disclose the open percent area of the topsheet disclosed therein, it is evident that the reference has some value for the percent open area and is just silent as to what it is. Furthermore, the Office points to Duncan's recognition of varying the diameter of the lotion droplets. The Office states that with respect to claims 12 and 13, the immobilizing agent is considered to be the viscosity additive disclosed in column 2, lines 20-44 and for claim 21 the Office refers to column 3, lines 40-44. Moreover, for claim 22 which relates to C14 – C22 fatty acids, the Office asserts that Duncan anticipates this claim. As a result of these various assertions, the Office concludes that it would have been obvious to one of ordinary skill in the

art at the time the invention was made to provide the article of Duncan with the claimed percent open area. Appellants respectfully traverse this rejection.

Duncan relates to a diaper having an oleophobic-hydrophobic topsheet, the outer face of which is coated with a film of discrete droplets of an oleaginous moisture barrier material suitable for application to an infant's skin. Furthermore, the reference discloses that when "discontinuous surface films of a protective barrier material were therefore applied to the topsheet of disposable diapers to eliminate the need for separately applying the protective barrier by the parent at the time of diaper change"..."it was found that this approach was not effective on diapers which did not have a hydrophobic backsheet." See col. 1, line 71 – col. 2, line 9. Moreover, Duncan teaches that such hydrophobic topsheets functioned quite well with a freshly applied barrier film on its hydrophobic topsheet but tended to have a deleterious effect on the diaper when aged past the normal range of shelf life. This deleterious effect was taught to be a reduction in the in-use capacity of the diaper. See col. 2, lines 9 – 16. Appellants, however, find no teaching in the reference of the absorbent article of the present invention that includes a liquid impervious backsheet; a liquid pervious, **hydrophilic topsheet** joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, and C) an absorbent core position between said topsheet and said backsheet; wherein the lotion is applied to the liquid pervious topsheet in a predetermined pattern such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.

Appellants respectfully submit that the present invention would not have been obvious at the time Appellants arrived at the invention in view of the disclosure of Duncan. First, although the Office asserts that hydrophilic topsheets were known in the art since Duncan opts to utilize an oleophobic-hydrophobic topsheet, Appellants maintain that the claimed combination offers benefits that were not appreciated by Duncan or those skilled in the art prior to the disclosure of Duncan. First, as has been asserted previously by Appellants, Duncan fails to teach or suggest the liquid pervious, hydrophilic topsheet that is required by Appellants' claimed invention. In contrast, the reference teaches away from the inclusion of such a component via Duncan's disclosure of the utility of a hydrophobic topsheet as is known in the art when discontinuous surface films of a protective barrier material are applied to a topsheet. Additionally, Duncan teaches away from Appellants' hydrophilic topsheet in its invention which includes an oleophobic-hydrophobic topsheet. In particular, it is an object of the Duncan invention to provide a diaper topsheet having a critical surface tension that is sufficiently low in contrast with the surface tension of the oleaginous moisture barrier material and with that of waste fluids to prevent a drop of either from spreading on the web. See col. 3, lines 64 – 68 of Duncan. A disadvantage of the

Duncan topsheet, however, is that such a topsheet is slow in promoting transfer of urine to the underlying absorbent cores. See page 3, lines 13-15 of the present application. The Duncan reference goes on to teach various coatings or treating materials which can be employed to lower the surface tension of the web of the topsheet. See col. 4, lines 34-49. Each of these teachings goes squarely against the heart of the present invention which is directed toward providing a topsheet that is hydrophilic in its very nature by way of its constituents (whether by hydrophilic fibers or films or by hydrophilic coatings for such fibers or films), particularly in the macroscopic untreated regions where lotion is not present.

Moreover, the Office points out that hydrophilic topsheets were known in the art since Duncan uses a hydrophobic topsheet to solve a problem that existed with the use of a hydrophilic topsheet. In response to this rationale, Appellants respectfully offer that the Duncan reference still fails to teach or suggest the disposable article of the present invention that employs a hydrophilic topsheet onto which a lotion is applied in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%. Therefore, despite the Office's assertion that the present invention would have been obvious at the time of its evolution in view of Duncan, Appellants respectfully assert that this is absolutely not the case. In particular, obviousness of the invention cannot be found since Duncan fails to teach or suggest the desirability of each and every one of the requisite elements of Appellants' invention, namely the hydrophilic topsheet, a lotion applied to the topsheet in a pattern having a plurality of elements, each of the elements having a predetermined size such that the macroscopic regions of the topsheet are untreated, and a percent open area of from about 5 to about 99%. Since §103 requires having to show obviousness of the invention "as a whole," a comparison must be made between the prior art as a whole and the claimed subject matter as a whole. In re Langer and Haynes, 175 USPQ 169, 171 (CCPA 1972). Thus, it is not apparent from the teachings of Duncan in their entirety that Appellants' wholly claimed invention would have been obvious in view of the reference's shortcomings and teachings away. Furthermore, the Board of Patent Appeals and Interferences stated in Ex parte Clapp, 227 USPQ 972 (BPAI 1985):

"To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention obvious in light of the teachings of the references. "

In the present instance, the reference does not expressly or impliedly suggest the claimed combination nor does the Office present the requisite line of reasoning as to why to Appellants' claimed combination would have been obvious in light of the teachings of Duncan.

Based on the aforementioned failed teachings and teachings away from the present invention, Appellants respectfully assert that the present invention would not have been obvious in view of the Duncan disclosure.

**II. Claims 1, 4-7, 9-13, and 16-26 are not rendered obvious under 35 USC §103(a) by Duncan in view of Buchalter either because even the combination of the references fails to teach or suggest the claimed limitations of the present invention.**

Claims 1, 4-7, 9-13, and 16-26 have been rejected under 35 USC §103 as being unpatentable over Duncan in view of Buchalter. The Office states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the skin care composition of Buchalter on the diaper of Duncan so that the benefits of the skin care composition of Buchalter can be obtained on the article of Duncan. Appellants traverse this rejection as well

Buchalter relates to articles that are placed in contact with the body for use in applying cosmetics or therapeutic substances to the skin, wherein the articles comprise a substrate and a therapeutic or cosmetic composition carried by the substrate and comprising the oil phase of a cream formulation, the oil being a dry emulsifiable solid, which upon addition of moisture thereto forms an oil in water or water in oil emulsion. Given this disclosure, it is clear that Buchalter teaches away from the present invention since it focuses on transferring the lotion or therapeutic substance to the skin via the formation of an emulsion upon mixing with moisture from the skin. In contrast, the lotion of Appellants' claimed method is not dependent upon the presence of moisture for transfer to occur but rather is transferred to the skin or facilitated to transfer via mere normal contact, motion of the wearer, by body heat of the wearer. See page 13, lines 6-8 of the specification. Appellants therefore respectfully assert that it would not have been obvious to one skilled in the art to modify the subject matter disclosed in either Duncan or Buchalter to arrive at the present invention in view of Buchalter's teaching away.

Assuming arguendo, even if one were to combine the respective disclosures of Duncan and Buchalter to attempt to arrive at the present invention, such an endeavor would fail. This failure would result since both references teach away from certain aspects of the present invention, e.g., the requisite hydrophilic topsheet taught away from by Duncan and the lotion that is transferable to the skin of the wearer without the addition of moisture which is taught away from by Buchalter. These teachings make it clear that one skilled in the art would not have been motivated to arrive at the present invention since the teachings are, in fact, teachings away.

In view of these shortcomings, Appellants respectfully submit that the rejection of claims 1, 4-7, 9-13, and 16-26 under §103(a) over Duncan and Buchalter is improper. Consequently, Appellants request withdrawal of the rejection and reconsideration.

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Appellants' invention. Rather, the

Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. In re Grabiak, 222 USPQ2d 870, 872 (Fed. Cir. 1985). In the present instance, the "something" is missing. Furthermore, "obvious to try" is not a valid test of patentability. In re Dow Chemical Co., 5 PQ2d 1529 (CAFC 1988); In re Antonie, 195 USPQ 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. In re Cofer, 148 USPQ 268 (CCPA 1966). Moreover, it is well settled that obviousness cannot be established by a combination of references where one of the references teaches away from the claimed invention. In re Grasselli, 281 USPQ 769, 780 (Fed. Cir. 1983). These cited references, alone and in combination, fail to offer the requisite teaching or suggestion of each of the elements Appellants have claimed as key to the invention. Additionally, it is apparent that Duncan teaches away from a hydrophilic topsheet while the Buchalter reference teaches away from the present invention in its requirement of body fluids to aid in the transfer of the lotion from the article to the skin of the wearer. Thus, Appellants assert that the rejection of obviousness based on both Duncan and Buchalter is unfounded.

#### SUMMARY

For the above reasons, Appellants respectfully submit that the Office's rejections of Claims 1, 4-7, 9-13, and 16-26 are improper. Reversals by the Board of the Office's rejections are, therefore, respectfully requested.

Respectfully submitted,

By 

Dara M. Kendall  
Attorney for Appellants  
Registration No. 43,709  
Tel. No. (513) 626-1789

November 18, 2003  
Customer No. 27752



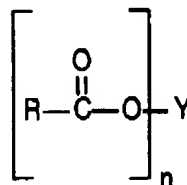
**APPENDIX**

Application No. 08/908,852

Claims on Appeal

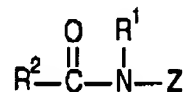
1. A disposable article comprising:
  - A) a liquid impervious backsheet;
  - B) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, and
  - C) an absorbent core positioned between said topsheet and said backsheet;  
wherein the lotion is applied to the liquid pervious topsheet in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.
4. The disposable article of Claim 1 wherein the percent open area of the topsheet is from about 5% to about 95%.
5. The disposable article of Claim 4 wherein the percent open area of the topsheet is from about 10% to about 90%.
6. The disposable article of Claim 5 wherein the percent open area of the topsheet is from about 20% to about 80%.
7. The disposable article of Claim 6 wherein the percent open area of the topsheet is from about 30% to about 70%.
9. The disposable article of Claim 1 wherein the lotion comprises a petroleum based emollient selected from the group consisting of mineral oil, petrolatum, and mixtures thereof.
13. A disposable article comprising:
  - A) a liquid impervious backsheet;
  - B) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

- i. from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C and comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;
  - ii. from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C; and
- C) an absorbent core position between said topsheet and said backsheet;
  - D) wherein the lotion is applied to the liquid pervious topsheet in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.
16. The disposable article of Claim 13 wherein the percent open area of the topsheet is from about 5% to about 95%.
  17. The disposable article of Claim 16 wherein the percent open area of the topsheet is from about 10% to about 90%.
  18. The disposable article of Claim 13 wherein said emollient contains about 5% or less water and comprises a petroleum based emollient selected from the group consisting of mineral oil, petrolatum, and mixtures thereof.
  19. The disposable article of Claim 18 wherein said emollient is petrolatum.
  20. The disposable article of Claim 18 wherein said emollient is mineral oil.
  21. The disposable article of Claim 13 wherein said lotion coating comprises from about 5 to about 50% of said immobilizing agent, said immobilizing agent having a melting point of at least about 40°C.
  22. The disposable article of Claim 21 wherein said immobilizing agent comprises a C<sub>14</sub> – C<sub>22</sub> fatty alcohol.
  23. The disposable article of Claim 22 wherein said immobilizing agent comprises a C<sub>16</sub> – C<sub>18</sub> fatty alcohol selected from the group consisting of cetyl alcohol, stearyl alcohol, and mixtures thereof.
  24. The disposable article of Claim 21 wherein said immobilizing agent comprises a polyhydroxy fatty acid ester having the formula:



wherein R is a C<sub>5</sub> – C<sub>31</sub> hydrocarbyl group; Y is a polyhydroxyhydrocarbyl moiety having a hydrocarbyl chain with at least 2 free hydroxyls directly connected to the chain and n is at least 1.

25. The disposable article of Claim 21 wherein said immobilizing agent comprises a polyhydroxy fatty acid amide having the formula:



wherein R<sup>1</sup> is H, C<sub>1</sub> – C<sub>4</sub> hydrocarbyl, 2-hydroxyethyl, 2-hydroxypropyl, methoxyethyl, methoxypropyl or a mixture thereof; R<sup>2</sup> is a C<sub>5</sub> – C<sub>31</sub> hydrocarbyl group; and Z is a polyhydroxyhydrocarbyl moiety having a linear hydrocarbyl chain with at least 3 hydroxyls directly connected to the chain.

26. The disposable article of Claim 21 wherein said immobilizing agent comprises a paraffin wax.

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Claims 1, 4-7, 9-13, and 16-22 have been rejected under 35 USC §103 as being unpatentable over Duncan. The Office reasons that Duncan discloses the following with respect to claims 1, 4-7, 9-11, 13, and 16-20: 1) a topsheet 12, 2) absorbent 11, 3) backsheet 11a, 4) that the topsheet has multiple discrete droplets of a lotion composition 14a, 5) that the discrete droplets of lotion have macroscopic areas between them that have no lotion, 6) the droplets have sizes ranging from 0.05 – 1.0 mm, and that 7) use of a hydrophilic topsheet was known. The Office goes on to state that even though Duncan is mainly concerned with a hydrophobic topsheet, the reference teaches that it was previously known to use lotion on a hydrophilic topsheet. Additionally, the Office goes on to assert that although Duncan does not disclose the open percent area of the topsheet disclosed therein, it is evident that the reference has some value for the percent open area and is just silent as to what it is. Furthermore, the Office points to Duncan's recognition of varying the diameter of the lotion droplets. The Office states that with respect to claims 12 and 13, the immobilizing agent is considered to be the viscosity additive disclosed in column 2, lines 20-44 and for claim 21 the Office refers to column 3, lines 40-44. Moreover, for claim 22 which relates to C14 – C22 fatty acids, the Office asserts that Duncan anticipates this claim. As a result of these various assertions, the Office concludes that it would have been obvious to one of ordinary skill in the

art at the time the invention was made to provide the article of Duncan with the claimed percent open area. Appellants respectfully traverse this rejection.

Duncan relates to a diaper having an oleophobic-hydrophobic topsheet, the outer face of which is coated with a film of discrete droplets of an oleaginous moisture barrier material suitable for application to an infant's skin. Furthermore, the reference discloses that when "discontinuous surface films of a protective barrier material were therefore applied to the topsheet of disposable diapers to eliminate the need for separately applying the protective barrier by the parent at the time of diaper change"..."it was found that this approach was not effective on diapers which did not have a hydrophobic backsheet." See col. 1, line 71 – col. 2, line 9. Moreover, Duncan teaches that such hydrophobic topsheets functioned quite well with a freshly applied barrier film on its hydrophobic topsheet but tended to have a deleterious effect on the diaper when aged past the normal range of shelf life. This deleterious effect was taught to be a reduction in the in-use capacity of the diaper. See col. 2, lines 9 – 16. Appellants, however, find no teaching in the reference of the absorbent article of the present invention that includes a liquid impervious backsheet; a liquid pervious, **hydrophilic topsheet** joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, and C) an absorbent core position between said topsheet and said backsheet; wherein the lotion is applied to the liquid pervious topsheet in a predetermined pattern such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.

Appellants respectfully submit that the present invention would not have been obvious at the time Appellants arrived at the invention in view of the disclosure of Duncan. First, although the Office asserts that hydrophilic topsheets were known in the art since Duncan opts to utilize an oleophobic-hydrophobic topsheet, Appellants maintain that the claimed combination offers benefits that were not appreciated by Duncan or those skilled in the art prior to the disclosure of Duncan. First, as has been asserted previously by Appellants, Duncan fails to teach or suggest the liquid pervious, hydrophilic topsheet that is required by Appellants' claimed invention. In contrast, the reference teaches away from the inclusion of such a component via Duncan's disclosure of the utility of a hydrophobic topsheet as is known in the art when discontinuous surface films of a protective barrier material are applied to a topsheet. Additionally, Duncan teaches away from Appellants' hydrophilic topsheet in its invention which includes an oleophobic-hydrophobic topsheet. In particular, it is an object of the Duncan invention to provide a diaper topsheet having a critical surface tension that is sufficiently low in contrast with the surface tension of the oleaginous moisture barrier material and with that of waste fluids to prevent a drop of either from spreading on the web. See col. 3, lines 64 – 68 of Duncan. A disadvantage of the

Duncan topsheet, however, is that such a topsheet is slow in promoting transfer of urine to the underlying absorbent cores. See page 3, lines 13-15 of the present application. The Duncan reference goes on to teach various coatings or treating materials which can be employed to lower the surface tension of the web of the topsheet. See col. 4, lines 34-49. Each of these teachings goes squarely against the heart of the present invention which is directed toward providing a topsheet that is hydrophilic in its very nature by way of its constituents (whether by hydrophilic fibers or films or by hydrophilic coatings for such fibers or films), particularly in the macroscopic untreated regions where lotion is not present.

Moreover, the Office points out that hydrophilic topsheets were known in the art since Duncan uses a hydrophobic topsheet to solve a problem that existed with the use of a hydrophilic topsheet. In response to this rationale, Appellants respectfully offer that the Duncan reference still fails to teach or suggest the disposable article of the present invention that employs a hydrophilic topsheet onto which a lotion is applied in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%. Therefore, despite the Office's assertion that the present invention would have been obvious at the time of its evolution in view of Duncan, Appellants respectfully assert that this is absolutely not the case. In particular, obviousness of the invention cannot be found since Duncan fails to teach or suggest the desirability of each and every one of the requisite elements of Appellants' invention, namely the hydrophilic topsheet, a lotion applied to the topsheet in a pattern having a plurality of elements, each of the elements having a predetermined size such that the macroscopic regions of the topsheet are untreated, and a percent open area of from about 5 to about 99%. Since §103 requires having to show obviousness of the invention "as a whole," a comparison must be made between the prior art as a whole and the claimed subject matter as a whole. In re Langer and Haynes, 175 USPQ 169, 171 (CCPA 1972). Thus, it is not apparent from the teachings of Duncan in their entirety that Appellants' wholly claimed invention would have been obvious in view of the reference's shortcomings and teachings away. Furthermore, the Board of Patent Appeals and Interferences stated in Ex parte Clapp, 227 USPQ 972 (BPAI 1985):

"To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention obvious in light of the teachings of the references. "

In the present instance, the reference does not expressly or impliedly suggest the claimed combination nor does the Office present the requisite line of reasoning as to why Appellants' claimed combination would have been obvious in light of the teachings of Duncan.



Based on the aforementioned failed teachings and teachings away from the present invention, Appellants respectfully assert that the present invention would not have been obvious in view of the Duncan disclosure.

**II. Claims 1, 4-7, 9-13, and 16-26 are not rendered obvious under 35 USC §103(a) by Duncan in view of Buchalter either because even the combination of the references fails to teach or suggest the claimed limitations of the present invention.**

Claims 1, 4-7, 9-13, and 16-26 have been rejected under 35 USC §103 as being unpatentable over Duncan in view of Buchalter. The Office states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the skin care composition of Buchalter on the diaper of Duncan so that the benefits of the skin care composition of Buchalter can be obtained on the article of Duncan. Appellants traverse this rejection as well

Buchalter relates to articles that are placed in contact with the body for use in applying cosmetics or therapeutic substances to the skin, wherein the articles comprise a substrate and a therapeutic or cosmetic composition carried by the substrate and comprising the oil phase of a cream formulation, the oil being a dry emulsifiable solid, which upon addition of moisture thereto forms an oil in water or water in oil emulsion. Given this disclosure, it is clear that Buchalter teaches away from the present invention since it focuses on transferring the lotion or therapeutic substance to the skin via the formation of an emulsion upon mixing with moisture from the skin. In contrast, the lotion of Appellants' claimed method is not dependent upon the presence of moisture for transfer to occur but rather is transferred to the skin or facilitated to transfer via mere normal contact, motion of the wearer, by body heat of the wearer. See page 13, lines 6-8 of the specification. Appellants therefore respectfully assert that it would not have been obvious to one skilled in the art to modify the subject matter disclosed in either Duncan or Buchalter to arrive at the present invention in view of Buchalter's teaching away.

Assuming arguendo, even if one were to combine the respective disclosures of Duncan and Buchalter to attempt to arrive at the present invention, such an endeavor would fail. This failure would result since both references teach away from certain aspects of the present invention, e.g., the requisite hydrophilic topsheet taught away from by Duncan and the lotion that is transferable to the skin of the wearer without the addition of moisture which is taught away from by Buchalter. These teachings make it clear that one skilled in the art would not have been motivated to arrive at the present invention since the teachings are, in fact, teachings away.

In view of these shortcomings, Appellants respectfully submit that the rejection of claims 1, 4-7, 9-13, and 16-26 under §103(a) over Duncan and Buchalter is improper. Consequently, Appellants request withdrawal of the rejection and reconsideration.

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Appellants' invention. Rather, the

Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. In re Grabiak, 222 USPQ2d 870, 872 (Fed. Cir. 1985). In the present instance, the "something" is missing. Furthermore, "obvious to try" is not a valid test of patentability. In re Dow Chemical Co., 5 PQ2d 1529 (CAFC 1988); In re Antonie, 195 USPQ 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. In re Cofer, 148 USPQ 268 (CCPA 1966). Moreover, it is well settled that obviousness cannot be established by a combination of references where one of the references teaches away from the claimed invention. In re Grasselli, 281 USPQ 769, 780 (Fed. Cir. 1983). These cited references, alone and in combination, fail to offer the requisite teaching or suggestion of each of the elements Appellants have claimed as key to the invention. Additionally, it is apparent that Duncan teaches away from a hydrophilic topsheet while the Buchalter reference teaches away from the present invention in its requirement of body fluids to aid in the transfer of the lotion from the article to the skin of the wearer. Thus, Appellants assert that the rejection of obviousness based on both Duncan and Buchalter is unfounded.

#### SUMMARY

For the above reasons, Appellants respectfully submit that the Office's rejections of Claims 1, 4-7, 9-13, and 16-26 are improper. Reversals by the Board of the Office's rejections are, therefore, respectfully requested.

Respectfully submitted,

By 

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Attorney for Appellants  
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Tel. No. (513) 626-1789

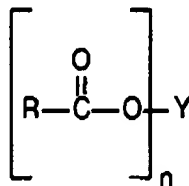
November 18, 2003  
Customer No. 27752

**APPENDIX**

Application No. 08/908,852  
Claims on Appeal

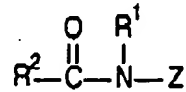
1. A disposable article comprising:
  - A) a liquid impervious backsheet;
  - B) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, and
  - C) an absorbent core positioned between said topsheet and said backsheet;  
wherein the lotion is applied to the liquid pervious topsheet in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.
4. The disposable article of Claim 1 wherein the percent open area of the topsheet is from about 5% to about 95%.
5. The disposable article of Claim 4 wherein the percent open area of the topsheet is from about 10% to about 90%.
6. The disposable article of Claim 5 wherein the percent open area of the topsheet is from about 20% to about 80%.
7. The disposable article of Claim 6 wherein the percent open area of the topsheet is from about 30% to about 70%.
9. The disposable article of Claim 1 wherein the lotion comprises a petroleum based emollient selected from the group consisting of mineral oil, petrolatum, and mixtures thereof.
13. A disposable article comprising:
  - A) a liquid impervious backsheet;
  - B) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

- i. from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C and comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;
  - ii. from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C; and
- C) an absorbent core positioned between said topsheet and said backsheet;
- D) wherein the lotion is applied to the liquid pervious topsheet in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.
- 16. The disposable article of Claim 13 wherein the percent open area of the topsheet is from about 5% to about 95%.
- 17. The disposable article of Claim 16 wherein the percent open area of the topsheet is from about 10% to about 90%.
- 18. The disposable article of Claim 13 wherein said emollient contains about 5% or less water and comprises a petroleum based emollient selected from the group consisting of mineral oil, petrolatum, and mixtures thereof.
- 19. The disposable article of Claim 18 wherein said emollient is petrolatum.
- 20. The disposable article of Claim 18 wherein said emollient is mineral oil.
- 21. The disposable article of Claim 13 wherein said lotion coating comprises from about 5 to about 50% of said immobilizing agent, said immobilizing agent having a melting point of at least about 40°C.
- 22. The disposable article of Claim 21 wherein said immobilizing agent comprises a C<sub>14</sub> – C<sub>22</sub> fatty alcohol.
- 23. The disposable article of Claim 22 wherein said immobilizing agent comprises a C<sub>16</sub> – C<sub>18</sub> fatty alcohol selected from the group consisting of cetyl alcohol, stearyl alcohol, and mixtures thereof.
- 24. The disposable article of Claim 21 wherein said immobilizing agent comprises a polyhydroxy fatty acid ester having the formula:



wherein R is a C<sub>5</sub> – C<sub>31</sub> hydrocarbyl group; Y is a polyhydroxyhydrocarbyl moiety having a hydrocarbyl chain with at least 2 free hydroxyls directly connected to the chain and n is at least 1.

25. The disposable article of Claim 21 wherein said immobilizing agent comprises a polyhydroxy fatty acid amide having the formula:



wherein R<sup>1</sup> is H, C<sub>1</sub> – C<sub>4</sub> hydrocarbyl, 2-hydroxyethyl, 2-hydroxypropyl, methoxyethyl, methoxypropyl or a mixture thereof; R<sup>2</sup> is a C<sub>5</sub> – C<sub>31</sub> hydrocarbyl group; and Z is a polyhydroxyhydrocarbyl moiety having a linear hydrocarbyl chain with at least 3 hydroxyls directly connected to the chain.

26. The disposable article of Claim 21 wherein said immobilizing agent comprises a paraffin wax.

P&amp;G Case 5494CRL

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of :  
D. C. Roe et al. : Confirmation No. 9941  
Serial No.: 08/908,852 : Group Art Unit 3761  
Filed: August 8, 1997 : Examiner D. Ruhl

For DIAPER HAVING A LOTIONED  
TOPSHEET

APPEAL BRIEF

Box AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is submitted in support of the Notice of Appeal submitted to the USPTO on September 18, 2003 via facsimile and received by the USPTO on the same day, which set a two(2)-month period for submission of this Brief. This Appeal Brief is being filed in triplicate.

REAL PARTY IN INTEREST

This Application has been assigned to The Procter & Gamble Company of Cincinnati, Ohio. The inventors, Donald Carroll Roe, Laura Graves Spalding Van Rijswijk, and Julie Charlene Rule, assigned their interest to the Procter & Gamble Company in an assignment corresponding to application Serial No.09/908,852, filed August 8, 1997 (recorded on November 14, 1997, at reel number 8833, and frame number 885).

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellant, or known to Appellant's legal representative, that will directly affect the Board's decision in the present appeal.

STATUS OF CLAIMS

The present application was originally filed with claims 1-27. On April 3, 2000, Appellants mailed in a response that amended the application by canceling claim 27. In a Response/Amendment mailed on March 26, 2001, Appellants canceled claims 2, 3, 8, 14, and 15. Therefore, in the Office Action mailed on June 18, 2003, the Office finally rejected claims 1, 4-7, 9-13, and 16-26. Accordingly, Appellants hereby appeal the rejection of

each of these claims that have been finally rejected. A complete copy of the appealed claims is set forth in the Appendix.

#### STATUS OF AMENDMENTS

No amendments were filed after the final rejection of the claims mailed by the Office on June 18, 2003.

#### SUMMARY OF INVENTION

The present invention relates to a disposable article comprising: A) a liquid impervious backsheet; B) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, and C) an absorbent core positioned between said topsheet and said backsheet; wherein the lotion is applied to the liquid pervious topsheet in a predetermined pattern such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%. Appellants have found that such articles resulting from the claimed method yield articles that exhibit an improved efficacy in aiding in the adherence of bowel movement to the skin of the wearer, thereby improving the ease of cleaning up the typical mess associated with such events.

#### ISSUES

Appellants present the following issues for consideration on appeal:

- I. Claims 1, 4-7, 9-13, and 16-22 have been rejected under 35 USC §103(a) as being unpatentable over Duncan et al. (USP 3489148) and
- II. Claims 1, 4-7, 9-13, and 16-26 have been rejected under 35 USC §103(a) as being unpatentable over Duncan in view of Buchalter (USP 3896807).

#### GROUPING OF CLAIMS

Claims 1, 4-7, 9-13, and 16-26 stand or fall together.

#### ARGUMENTS

Claims 1, 4-7, 9-13, and 16-22 have been rejected under 35 USC §103 as being unpatentable over Duncan. The Office reasons that Duncan discloses the following: 1) a topsheet 12, 2) absorbent 11, 3) backsheet 11a, 4) that the topsheet has multiple discrete droplets of a lotion composition 14a, 5) that the discrete droplets of lotion have macroscopic areas between them that have no lotion, 6) the droplets have sizes

ranging from 0.05 – 1.0 mm, and that 7) use of a hydrophilic topsheet was known. The Office goes on to state that even though Duncan is mainly concerned with a hydrophobic topsheet, the reference teaches that it was previously known to use lotion on a hydrophilic topsheet. Additionally, the Office goes on to assert that although Duncan does not disclose the open percent area of the topsheet disclosed therein, it is evident that the reference has some value for the percent open area and is just silent as to what it is. Furthermore, the Office points to Duncan's recognition of varying the diameter of the lotion droplets. As a result of these assertions, the Office concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Duncan with the claimed percent open area.

Additionally, Claims 1, 4-7, 9-13, and 16-26 have been rejected under 35 USC §103 as being unpatentable over Duncan in view of Buchalter. The Office states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the skin care composition of Buchalter on the diaper of Duncan so that the benefits of the skin care composition of Buchalter can be obtained on the article of Duncan.

For the reasons discussed below, Appellants submit that the appealed claims are not rendered obvious in view of Duncan alone or in combination with Buchalter. Accordingly, the Board should reverse the Office's rejections. A favorable action by the Board is respectfully requested.

**I. Claims 1, 4-7, 9-13, and 16-22 are not rendered obvious under 35 USC §103(a) by Duncan because the reference fails to teach or suggest the claimed limitations of the present invention.**

Claims 1, 4-7, 9-13, and 16-22 have been rejected under 35 USC §103 as being unpatentable over Duncan. The Office reasons that Duncan discloses the following with respect to claims 1, 4-7, 9-11, 13, and 16-20: 1) a topsheet 12, 2) absorbent 11, 3) backsheet 11a, 4) that the topsheet has multiple discrete droplets of a lotion composition 14a, 5) that the discrete droplets of lotion have macroscopic areas between them that have no lotion, 6) the droplets have sizes ranging from 0.05 – 1.0 mm, and that 7) use of a hydrophilic topsheet was known. The Office goes on to state that even though Duncan is mainly concerned with a hydrophobic topsheet, the reference teaches that it was previously known to use lotion on a hydrophilic topsheet. Additionally, the Office goes on to assert that although Duncan does not disclose the open percent area of the topsheet disclosed therein, it is evident that the reference has some value for the percent open area and is just silent as to what it is. Furthermore, the Office points to Duncan's recognition of varying the diameter of the lotion droplets. The Office states that with respect to claims 12 and 13, the immobilizing agent is considered to be the viscosity additive disclosed in column 2, lines 20-44 and for claim 21 the Office refers to column 3, lines 40-44. Moreover, for claim 22 which relates to C14 – C22 fatty acids, the Office asserts that Duncan anticipates this claim. As a result of these various assertions, the Office concludes that it would have been obvious to one of ordinary skill in the



art at the time the invention was made to provide the article of Duncan with the claimed percent open area. Appellants respectfully traverse this rejection.

Duncan relates to a diaper having an oleophobic-hydrophobic topsheet, the outer face of which is coated with a film of discrete droplets of an oleaginous moisture barrier material suitable for application to an infant's skin. Furthermore, the reference discloses that when "discontinuous surface films of a protective barrier material were therefore applied to the topsheet of disposable diapers to eliminate the need for separately applying the protective barrier by the parent at the time of diaper change"... "it was found that this approach was not effective on diapers which did not have a hydrophobic backsheet." See col. 1, line 71 – col. 2, line 9. Moreover, Duncan teaches that such hydrophobic topsheets functioned quite well with a freshly applied barrier film on its hydrophobic topsheet but tended to have a deleterious effect on the diaper when aged past the normal range of shelf life. This deleterious effect was taught to be a reduction in the in-use capacity of the diaper. See col. 2, lines 9 – 16. Appellants, however, find no teaching in the reference of the absorbent article of the present invention that includes a liquid impervious backsheet; a liquid pervious, **hydrophilic topsheet** joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, and C) an absorbent core position between said topsheet and said backsheet; wherein the lotion is applied to the liquid pervious topsheet in a predetermined pattern such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.

Appellants respectfully submit that the present invention would not have been obvious at the time Appellants arrived at the invention in view of the disclosure of Duncan. First, although the Office asserts that hydrophilic topsheets were known in the art since Duncan opts to utilize an oleophobic-hydrophobic topsheet, Appellants maintain that the claimed combination offers benefits that were not appreciated by Duncan or those skilled in the art prior to the disclosure of Duncan. First, as has been asserted previously by Appellants, Duncan fails to teach or suggest the liquid pervious, hydrophilic topsheet that is required by Appellants' claimed invention. In contrast, the reference teaches away from the inclusion of such a component via Duncan's disclosure of the utility of a hydrophobic topsheet as is known in the art when discontinuous surface films of a protective barrier material are applied to a topsheet. Additionally, Duncan teaches away from Appellants' hydrophilic topsheet in its invention which includes an oleophobic-hydrophobic topsheet. In particular, it is an object of the Duncan invention to provide a diaper topsheet having a critical surface tension that is sufficiently low in contrast with the surface tension of the oleaginous moisture barrier material and with that of waste fluids to prevent a drop of either from spreading on the web. See col. 3, lines 64 – 68 of Duncan. A disadvantage of the

Duncan topsheet, however, is that such a topsheet is slow in promoting transfer of urine to the underlying absorbent cores. See page 3, lines 13-15 of the present application. The Duncan reference goes on to teach various coatings or treating materials which can be employed to lower the surface tension of the web of the topsheet. See col. 4, lines 34-49. Each of these teachings goes squarely against the heart of the present invention which is directed toward providing a topsheet that is hydrophilic in its very nature by way of its constituents (whether by hydrophilic fibers or films or by hydrophilic coatings for such fibers or films), particularly in the macroscopic untreated regions where lotion is not present.

Moreover, the Office points out that hydrophilic topsheets were known in the art since Duncan uses a hydrophobic topsheet to solve a problem that existed with the use of a hydrophilic topsheet. In response to this rationale, Appellants respectfully offer that the Duncan reference still fails to teach or suggest the disposable article of the present invention that employs a hydrophilic topsheet onto which a lotion is applied in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%. Therefore, despite the Office's assertion that the present invention would have been obvious at the time of its evolution in view of Duncan, Appellants respectfully assert that this is absolutely not the case. In particular, obviousness of the invention cannot be found since Duncan fails to teach or suggest the desirability of each and every one of the requisite elements of Appellants' invention, namely the hydrophilic topsheet, a lotion applied to the topsheet in a pattern having a plurality of elements, each of the elements having a predetermined size such that the macroscopic regions of the topsheet are untreated, and a percent open area of from about 5 to about 99%. Since §103 requires having to show obviousness of the invention "as a whole," a comparison must be made between the prior art as a whole and the claimed subject matter as a whole. In re Langer and Haynes, 175 USPQ 169, 171 (CCPA 1972). Thus, it is not apparent from the teachings of Duncan in their entirety that Appellants' wholly claimed invention would have been obvious in view of the reference's shortcomings and teachings away. Furthermore, the Board of Patent Appeals and Interferences stated in Ex parte Clapp, 227 USPQ 972 (BPAI 1985):

"To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention obvious in light of the teachings of the references."

In the present instance, the reference does not expressly or impliedly suggest the claimed combination nor does the Office present the requisite line of reasoning as to why to Appellants' claimed combination would have been obvious in light of the teachings of Duncan.

Based on the aforementioned failed teachings and teachings away from the present invention, Appellants respectfully assert that the present invention would not have been obvious in view of the Duncan disclosure.

II. Claims 1, 4-7, 9-13, and 16-26 are not rendered obvious under 35 USC §103(a) by Duncan in view of Buchalter either because even the combination of the references fails to teach or suggest the claimed limitations of the present invention.

Claims 1, 4-7, 9-13, and 16-26 have been rejected under 35 USC §103 as being unpatentable over Duncan in view of Buchalter. The Office states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the skin care composition of Buchalter on the diaper of Duncan so that the benefits of the skin care composition of Buchalter can be obtained on the article of Duncan. Appellants traverse this rejection as well

Buchalter relates to articles that are placed in contact with the body for use in applying cosmetics or therapeutic substances to the skin, wherein the articles comprise a substrate and a therapeutic or cosmetic composition carried by the substrate and comprising the oil phase of a cream formulation, the oil being a dry emulsifiable solid, which upon addition of moisture thereto forms an oil in water or water in oil emulsion. Given this disclosure, it is clear that Buchalter teaches away from the present invention since it focuses on transferring the lotion or therapeutic substance to the skin via the formation of an emulsion upon mixing with moisture from the skin. In contrast, the lotion of Appellants' claimed method is not dependent upon the presence of moisture for transfer to occur but rather is transferred to the skin or facilitated to transfer via mere normal contact, motion of the wearer, by body heat of the wearer. See page 13, lines 6-8 of the specification. Appellants therefore respectfully assert that it would not have been obvious to one skilled in the art to modify the subject matter disclosed in either Duncan or Buchalter to arrive at the present invention in view of Buchalter's teaching away.

Assuming arguendo, even if one were to combine the respective disclosures of Duncan and Buchalter to attempt to arrive at the present invention, such an endeavor would fail. This failure would result since both references teach away from certain aspects of the present invention, e.g., the requisite hydrophilic topsheet taught away from by Duncan and the lotion that is transferable to the skin of the wearer without the addition of moisture which is taught away from by Buchalter. These teachings make it clear that one skilled in the art would not have been motivated to arrive at the present invention since the teachings are, in fact, teachings away.

In view of these shortcomings, Appellants respectfully submit that the rejection of claims 1, 4-7, 9-13, and 16-26 under §103(a) over Duncan and Buchalter is improper. Consequently, Appellants request withdrawal of the rejection and reconsideration.

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Appellants' invention. Rather, the

Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. In re Grabiak, 222 USPQ2d 870, 872 (Fed. Cir. 1985). In the present instance, the "something" is missing. Furthermore, "obvious to try" is not a valid test of patentability. In re Dow Chemical Co., 5 PQ2d 1529 (CAFC 1988); In re Antonie, 195 USPQ 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. In re Cofer, 148 USPQ 268 (CCPA 1966). Moreover, it is well settled that obviousness cannot be established by a combination of references where one of the references teaches away from the claimed invention. In re Grasselli, 281 USPQ 769, 780 (Fed. Cir. 1983). These cited references, alone and in combination, fail to offer the requisite teaching or suggestion of each of the elements Appellants have claimed as key to the invention. Additionally, it is apparent that Duncan teaches away from a hydrophilic topsheet while the Buchalter reference teaches away from the present invention in its requirement of body fluids to aid in the transfer of the lotion from the article to the skin of the wearer. Thus, Appellants assert that the rejection of obviousness based on both Duncan and Buchalter is unfounded.

#### SUMMARY

For the above reasons, Appellants respectfully submit that the Office's rejections of Claims 1, 4-7, 9-13, and 16-26 are improper. Reversals by the Board of the Office's rejections are, therefore, respectfully requested.

Respectfully submitted,

By 

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November 18, 2003  
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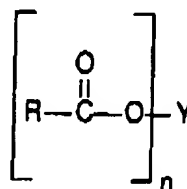
**APPENDIX**

Application No. 08/908,852

Claims on Appeal

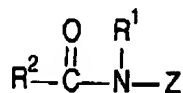
1. A disposable article comprising:
  - A) a liquid impervious backsheet;
  - B) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, and
  - C) an absorbent core positioned between said topsheet and said backsheet;  
wherein the lotion is applied to the liquid pervious topsheet in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.
4. The disposable article of Claim 1 wherein the percent open area of the topsheet is from about 5% to about 95%.
5. The disposable article of Claim 4 wherein the percent open area of the topsheet is from about 10% to about 90%.
6. The disposable article of Claim 5 wherein the percent open area of the topsheet is from about 20% to about 80%.
7. The disposable article of Claim 6 wherein the percent open area of the topsheet is from about 30% to about 70%.
9. The disposable article of Claim 1 wherein the lotion comprises a petroleum based emollient selected from the group consisting of mineral oil, petrolatum, and mixtures thereof.
13. A disposable article comprising:
  - A) a liquid impervious backsheet;
  - B) a liquid pervious, hydrophilic topsheet joined to said backsheet, said topsheet having an inner surface oriented toward an interior of said article and an outer surface oriented toward the skin of a wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount to reduce adherence of bowel movements to the skin of the wearer of a lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

- i. from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C and comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;
  - ii. from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C; and
- C) an absorbent core position between said topsheet and said backsheet;
- D) wherein the lotion is applied to the liquid pervious topsheet in a pattern having a plurality of elements, each having a predetermined size such that the macroscopic regions of the topsheet are untreated and the topsheet has a percent open area of from about 5% to about 99%.
- 16. The disposable article of Claim 13 wherein the percent open area of the topsheet is from about 5% to about 95%.
- 17. The disposable article of Claim 16 wherein the percent open area of the topsheet is from about 10% to about 90%.
- 18. The disposable article of Claim 13 wherein said emollient contains about 5% or less water and comprises a petroleum based emollient selected from the group consisting of mineral oil, petrolatum, and mixtures thereof.
- 19. The disposable article of Claim 18 wherein said emollient is petrolatum.
- 20. The disposable article of Claim 18 wherein said emollient is mineral oil.
- 21. The disposable article of Claim 13 wherein said lotion coating comprises from about 5 to about 50% of said immobilizing agent, said immobilizing agent having a melting point of at least about 40°C.
- 22. The disposable article of Claim 21 wherein said immobilizing agent comprises a C<sub>14</sub> - C<sub>22</sub> fatty alcohol.
- 23. The disposable article of Claim 22 wherein said immobilizing agent comprises a C<sub>18</sub> - C<sub>18</sub> fatty alcohol selected from the group consisting of cetyl alcohol, stearyl alcohol, and mixtures thereof.
- 24. The disposable article of Claim 21 wherein said immobilizing agent comprises a polyhydroxy fatty acid ester having the formula:



wherein R is a C<sub>5</sub> - C<sub>31</sub> hydrocarbyl group; Y is a polyhydroxyhydrocarbyl moiety having a hydrocarbyl chain with at least 2 free hydroxyls directly connected to the chain and n is at least 1.

25. The disposable article of Claim 21 wherein said immobilizing agent comprises a polyhydroxy fatty acid amide having the formula:



wherein R<sup>1</sup> is H, C<sub>1</sub> - C<sub>4</sub> hydrocarbyl, 2-hydroxyethyl, 2-hydroxypropyl, methoxyethyl, methoxypropyl or a mixture thereof; R<sup>2</sup> is a C<sub>5</sub> - C<sub>31</sub> hydrocarbyl group; and Z is a polyhydroxyhydrocarbyl moiety having a linear hydrocarbyl chain with at least 3 hydroxyls directly connected to the chain.

26. The disposable article of Claim 21 wherein said immobilizing agent comprises a paraffin wax.

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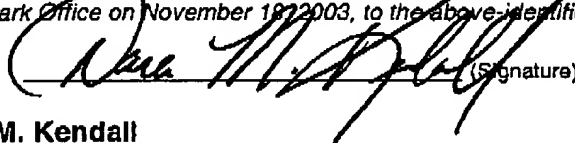
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Listed below are the item(s) being submitted  
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- 1) Brief on Appeal  
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- 2) Appeal Brief (10 pages)  
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Number of Pages Including this Page: 33

Inventor(s): Roe et al.  
S.N.: 08/908,852  
Filed: August 8, 1997  
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Comments: